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19 MAR 2007

In re Application of	:	
James et al.	:	
Application No.: 10/576,936	:	DECISION
PCT No.: PCT/GB04/04186	:	
Int. Filing Date: 01 October 2004	:	ON
Priority Date: 25 October 2003	:	
Attorney Docket No.: 066079-5128	:	PETITION
For: Process For Etching Metal And Alloy Surfaces	:	

This is in response to the petition under 37 CFR 1.47(a) filed on 19 January 2007.

### **BACKGROUND**

This international application was filed on 01 October 2004, claimed an earlier priority date of 25 October 2003, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 19 May 2005. The 30 month time period for paying the basic national fee in the United States expired at midnight on 25 April 2006. Applicants filed *inter alia* the basic national fee on 24 April 2006.

On 30 November 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration and a surcharge under 37 CFR 1.492(h).

### **DISCUSSION**

Petitioner indicates that joint inventor David John Cottrell is deceased, but that previously he allegedly refused to execute the declaration. Thus, treatment under 37 CFR 1.47(a) is appropriate. A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), petitioner paid the petition fee on 19 January 2007.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of now-deceased joint inventor David John Cottrell be excused because he "has refused to sign the declaration and related assignment of this application." Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands

exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Counsel refers to an accompanying "declaration by Amanda J. Collier" to show that Mr. Cottrell refused to execute the declaration. Ms. Collier states that, "On April 21, 2006, I sent the application with declaration and assignment to David Cottrell at his address of record in the company files..." for signature, followed by a "reminder" on 07 June 2006, but that she later learned that Mr. Cottrell "had moved." After learning that Mr. Cottrell had "moved," Ms. Collier states that she sent him further "reminder" letters, and that Mr. Cottrell "responded to the aforementioned letters by e-mail on September 1, 2006." However, it is not clear whether Mr. Cottrell was actually presented with an oath or declaration and a complete copy of this application, since it is not clear whether he received the correspondence sent to his previous address. Moreover, it is not clear whether a copy of this application was sent to him, since Ms. Collier's correspondence does not explicitly recite an application number; instead, it merely cites a case reference number which does not correspond to the present docket number of this application. Moreover, it is unclear whether Mr. Cottrell's email to Ms. Collier, dated 01 September 2006, evidences a "refusal" to execute the application. Rather, the email suggests that Mr. Cottrell did not understand his "interest in this area," suggesting that he believed himself to be "no longer required so I don't see what the issue is." This admits the possibility that Mr.

Cottrell may have been willing to execute the declaration if he had been apprised of the reasons his participation was still relevant and necessary. For all of these reasons, the evidence of record does not presently establish a "refusal" within the meaning of 37 CFR 1.47(a).

Regarding requirement (3), the petition does not include an affirmative and explicit statement of Mr. Cottrell's last known address. Though the supporting documentation refers to at least two addresses for Mr. Cottrell, and though Mr. Cottrell is understood to be deceased, neither of these circumstances satisfies or obviates requirement (3). Nor does the reference in the petition to Mr. Cottrell's "former residence" being listed in the declaration, since petitioner is not clearly referring to a "last known" address, and since the "Declaration of Amanda Collier" refers to more than one former address for Mr. Cottrell. To the extent that petitioner considers the address given in paragraph 21 of Ms. Collier's "Declaration..." to be Mr. Cottrell's "last-known" address, a statement to that effect by petitioner would be appropriate.

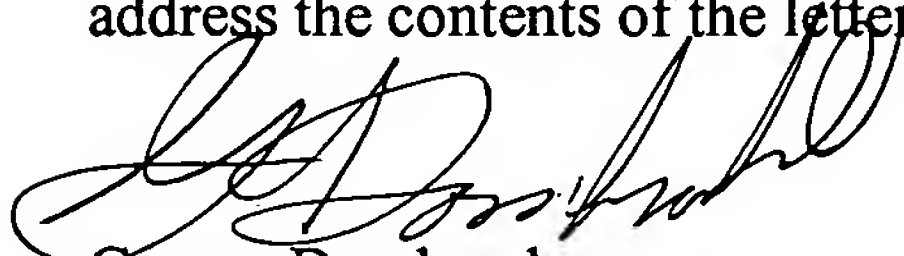
Regarding requirement (4), the petition is accompanied by a declaration document signed by joint inventor Mark Robert James on behalf of himself and non-signing joint inventor David John Cottrell. This declaration is acceptable for purposes of satisfying requirement (4).

### **DECISION**

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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